

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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UMICORE AG & CO. KG,

Petitioner,

v.

BASF CORPORATION

Patent Owner.

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IPR2015-01124  
U.S. Patent 8,404,203

**PATENT OWNER'S MOTION FOR LATE SUBMISSION OF  
SUPPLEMENTAL INFORMATION**

## I. INTRODUCTION

Petitioner (“Umicore”) has argued that the copper chabazite (“CuCHA”) catalyst claimed in the 203 Patent is obvious based on the combination of prior art describing the use of low SAR copper-exchanged zeolites for the selective catalytic reduction (SCR) of NO<sub>x</sub> and a process for de-aluminating zeolites to increase their SAR. Umicore further argues that the combination of these decades-old prior art elements produces predictable results, and more generally, that the ranges of atomic ratio of copper to aluminum (“Cu/Al ratio”) and silica-to-alumina ratio (“SAR”) claimed in the 203 Patent produce expected results. IPR2015-01124, Petition at 59-60. As explained in BASF’s Patent Owner Response, the combination of a CHA zeolite with the claimed Cu/Al ratio and SAR produced unexpected results in comparison to known prior art zeolite catalysts and solved a longstanding problem that was well documented in the prior art. BASF presents this motion to submit additional information showing that, not only does Umicore’s claim of obviousness run directly contrary to an array of objective publications regarding the use of zeolite catalysts for the SCR of NO<sub>x</sub>, but it also runs contrary to Umicore’s own prior statements. Specifically, statements by Umicore in U.S. Patent Application Publication No. 2016/0038875 (“the 875 Publication”) (Exhibit-2036) directly contradict Umicore’s contention that the claimed Cu/Al ratio and SAR in the 203 Patent are insignificant and produce

expected results. Therefore, and as explained more fully herein, BASF contends that consideration of the 875 Publication in these proceedings would be in the interests of justice.

BASF also contends that it could not have reasonably obtained the information earlier. BASF first learned of the 875 Publication when it was published in English on February 11, 2016 (the day before BASF's Patent Owner Response was due in the IPR). After examining the history of the 875 Publication and comparing it to the positions taken by Umicore in this IPR, BASF, on April 21, 2016, notified Umicore of the inconsistency and its intention to submit the 875 Publication to the Board. Umicore argues that BASF could have found the German language publication earlier by conducting searches, but offers no explanation for why BASF knew or should have known to search for inconsistent statements in Umicore's own later-filed CuCHA patent applications. Moreover, Umicore's position is at odds with the IPR rules, which require that "a party must serve relevant information that is inconsistent with a position advanced by the party." 37 C.F.R. § 42.51(b)(1)(iii). The existence of the earlier German publication and the 875 Publication fall squarely within the scope of this rule, and thus it was Umicore that was obligated to bring this information to light at the very outset of this proceeding.

BASF respectfully requests that the Board grant its motion for submission of

supplemental information.

## II. APPLICABLE RULES

A request for late submission of supplemental information is governed by 37 C.F.R. § 42.123(b) which states as follows: “A party seeking to submit supplemental information more than one month after the date the trial is instituted, must request authorization to file a motion to submit the information. The motion to submit supplemental information must show why the supplemental information reasonably could not have been obtained earlier, and that consideration of the supplemental information would be in the interests-of-justice.”

## III. ARGUMENT

### A. Consideration of the 875 Publication is in the Interests-of-Justice

Considering information that contradicts a parties’ stated position is in the interests-of-justice because it promotes the search for the truth. *See Edmund Optics*, Case No. IPR2014-00599, Paper 44 at 4 (“With respect to the issue of whether submission of the supplemental information is in the interests of justice, we are mindful that a trial is, first and foremost, a search for the truth.”) (citing *Nix v. Whiteside*, 475 U.S. 157, 166 (1986)). As explained below, the 875 Publication plainly contradicts Umicore’s position in the Petition that the Cu/Al ratio and SAR are insignificant and produce expected results.

The 203 Patent claims priority to a provisional application filed on February

27, 2007, and claims a CuCHA catalyst for the SCR of NO<sub>x</sub> having a Cu/Al ratio between 0.25 and 0.50, and a SAR between 15 and 100. Exhibit-1001 at Claim 1. The 203 Patent also includes dependent claims narrowing those ranges. *See, e.g.*, Exhibit-1001 at Claim 22 (requiring a Cu/Al ratio of about 0.40 and SAR of about between 30). Umicore asserts that the claimed CuCHA catalyst is obvious in view of Maeshima (U.S. 4,046,888), which discloses the use of metal-exchanged zeolites having a low SAR (2-6) for the SCR of NO<sub>x</sub>, and Breck (U.S. U.S. 4,503,023), which discloses a process for de-aluminating zeolites to increase their SAR.<sup>1</sup> In the Petition, Umicore contends that the combination of these references produces expected results because increasing Cu/Al and SAR results in a predictable and linear increase in NO<sub>x</sub> conversion. IPR2015-01124, Petition at 59-60. Umicore, however, paints an entirely different picture regarding predictability and significance of Cu/Al ratio and SAR ranges in its own patent application, the 875 Publication, directed to a CuCHA catalyst.

The 875 Publication stems from a PCT application that was filed in Europe on April 1, 2014. The U.S. national stage application was filed on September 25, 2015, and includes an oath signed on September 11, 2015 by the named inventor,

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<sup>1</sup> Umicore also asserts that Dedecek, which discloses a low SAR CuCHA zeolite, in combination with Breck renders the claims obvious.

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